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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215813
Party	Plaintiff Crystalline Management, LLC, Najat Kanache
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Attachments	CRONUT SECOND AMENDED NOTICE OF OPPOSITION.pdf(1548078 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

NAJAT KANACHE and)
CRYSTALLINE MANAGEMENT, LLC,)

Opposers,)

v.)

INTERNATIONAL PASTRY)
CONCEPTS LLC and)
DOMINIQUE ANSEL,)

Applicants.)

Opposition No.: 91215813

SECOND AMENDED NOTICE OF OPPOSITION

In the matter of the application of INTERNATIONAL PASTRY CONCEPTS LLC and DOMINIQUE ANSEL (hereinafter referred to as "Applicants") for registration of the designation CRONUT (hereinafter "CRONUT") in International Class 30 for "Bakery desserts; Bakery goods; Bakery goods and dessert items, namely, cheesecakes for retail and wholesale distribution and consumption on or off the premises; Bakery goods, namely, croissant and doughnut hybrid; Bakery products; Bakery products, namely, sweet bakery goods; Beverages made of coffee; Beverages made of tea; Beverages with a chocolate base; Beverages with a coffee base; Biscuits; Biscuits and bread; Biscuits, tarts, cakes made with cereals; Bread and buns; Bread and pastry; Bread doughs; Bread mixes; Bread rolls; Bread sticks; Brioche; Cake doughs; Cake icing; Cake mixes; Cakes; Chocolate for confectionery and bread; Cocoa-based beverages; Cocoa-based ingredient in confectionery products; Coffee based beverages; Coffee

beverages with milk; Coffee-based beverages; Coffee-based iced beverages; Confectioneries, namely, snack foods, namely, chocolate; Confectionery chips for baking; Cookie dough; Cookie mixes; Cookies; Croissants; Doughnuts; Edible cake decorations; Edible decorations for cakes; Edible flour; Food package combinations consisting primarily of bread, crackers and/or cookies; Instant doughnut mixes; Macaroons; Madeleines; Mixes for bakery goods; Muffin mixes; Muffins; Pastries; Pastry dough; Pastry mixes; Prepared cocoa and cocoa-based beverages; Prepared coffee and coffee-based beverages; Scones”, Serial No. 85936327 filed May 19, 2013, based upon a date of first use of May 10, 2013, which was published in the Official Gazette of the United States Patent and Trademark Office on December 10, 2013, NAJAT KANACHE, a citizen of Spain and CRYSTALLINE MANAGEMENT LLC, a limited liability company formed under the laws of Michigan (hereinafter referred to as "Opposers"), both located at 335 Paluxy Drive, Irving, Texas 75039, believe they will be damaged by registration of the designation CRONUT in said trademark application and hereby opposes the same.

The grounds for the opposition are as follows:

1. The term CRONUTS was coined, created and first used by Opposers, as a contraction of “creative donuts” and does not have any meaning in the English language or any other language as applied to Opposers’ sweet and savory donuts.
2. Opposers adopted and began using the trademark CRONUTS for sweet and savory doughnuts for goods sold in intrastate commerce before Applicants commenced using, and applied to register, the designation CRONUT for their goods.

3. Opposers have applied to register their CRONUTS mark, which is the subject of pending U.S. Application 85961168 filed on June 17, 2013, for “baked goods, namely, sweet donuts and savory donuts” in Class 30 (“the 168 application”), based upon an intention to use.

4. Opposers also filed on July 12, 2013, an application to register CRONUTS for “downloadable publications featuring recipes” in Class 9, “publications featuring recipes” in Class 16 and “non-downloadable publications featuring recipes” in Class 41, which is the subject of pending application SN 86008577 (“the 577 application”), also based upon an intention to use.

5. Applicants’ designation CRONUT is substantially identical to Opposers’ CRONUTS mark.

6. The goods set forth in Applicants’ CRONUT application include “doughnuts” which encompasses all types of doughnuts and thus are identical to Opposers’ goods.

7. The goods set forth in Applicants’ CRONUT application are, or will be, advertised, promoted, sold and distributed to customers who are the same customers to which Opposers said CRONUTS donuts are advertised and sold.

8. Applicants’ CRONUT application has been cited as a potential block against the ‘168 application because of confusing similarity.

Count I – Likelihood of Confusion – Section 2(d) of the Lanham Act

9. Opposers are users of the CRONUTS mark for sweet and savory donuts with rights prior to any rights Applicants may claim in the designation CRONUT.

10. Prospective and actual customers for Applicants’ CRONUT goods who

are familiar with Opposers and their CRONUTS goods will likely be confused, mistaken or deceived as to the source, origin, affiliation, connection or association of Applicants' goods, or suffer reverse confusion, mistake or deception that Opposers are junior users of their CRONUTS mark.

11. Registration of Applicants' designation CRONUT thus will damage Opposers within the meaning of Section 2 (d) of the Lanham Act, 15 U.S.C. Section 1052 (d).

Count II – Descriptiveness – Section 2(e)(1) Lanham Act

12. Opposers repeat and reallege paragraphs 1 through 11 as though fully set forth herein.

13. On information and belief, the term CRONUT refers to a hybrid donut / croissant.

14. One example of the descriptiveness of CRONUT is at <http://www.dailymail.co.uk/news/article-2389350/Cronut-recipe-Avoid-linesstay-home-Cronuts-masses.html#ixzz2g8ICZwBb> where appears an article titled "Make your own Cronuts: DIY manual allows food-craze fans to avoid the lines by making their own sugary treats at home".

15. Another example of the descriptiveness of CRONUT is at <https://sortedfood.com/recipe=2558>, where appears a recipe and video titled "How to make Cronuts", and which states "Cronuts are a mix between a croissant and a doughnut/donut, and are the most gorgeous sweet treats that have been taking over Manhattan and London for the last couple of months".

16. Another example of the descriptiveness of CRONUT is at

<http://gourmetfood.about.com/od/dessertrecipes/r/Diy-Homemade-Cronuts.htm>, where appears an article titled "DIY Home Made Cronuts" which states: "Cronuts are the latest dessert craze to hit the world. A cross between croissants and donuts = cronuts, they are wonderfully flaky and delicious".

17. Another example of the descriptiveness of CRONUT is at <http://www.wikihow.com/Make-Cronuts>, where appears an article titled 'How to Make Cronuts' which states: "A cronut is a crazy, delicious hybrid between a croissant and donut".

18. The examples of the descriptive uses of CRONUT set forth in paragraphs 14 through 17 above are not exhaustive as there are other uses on the Internet as well.

19. The United States Patent and Trademark Office also has refused registration of Opposers' CRONUTS mark in the '577 application on the basis that the mark is merely descriptive because an "average purchaser would believe that the term 'cronut' as applied to food, describes a hybrid croissant-doughnut party".

20. Accordingly, the term CRONUT as applied to Applicants' "bakery goods, namely, croissant and doughnut hybrid" in their CRONUT application merely describes their feature and characteristic of being a croissant and doughnut hybrid. CRONUT thus does not qualify for registration on the Principal Register as per Section 2(e)(1) of the Lanham Act.

21. Applicants' CRONUT application should, therefore, be denied registration on the Principal Register because of descriptiveness.

Count III – Lack of Bona Fide Use in Commerce – Section 1(a) Lanham Act

22. Opposers repeat and reallege paragraphs 1 through 21 as though fully set

forth herein.

23. On information and belief, at the time of filing their application to register CRONUT, Applicants had not used in interstate commerce the mark for the goods listed in their application.

24. Opposers are being damaged by the United States Patent and Trademark Office's acceptance of Applicants' CRONUT application. Accordingly, registration of the mark should be refused due to nonuse of the mark at the time the application was filed, under Section 1(a) of the Trademark Act.

Count IV – Misuse of registration symbol- Section 29 of the Lanham Act

25. Opposers repeat and reallege paragraphs 1 through 24 as though fully set forth herein.

26. On January 14, 2014, the United States Patent and Trademark Office issued to Applicants Registration No. 4465439 for CRONUT.

27. On February 21, 2014, the United States Patent and Trademark Office sent to Applicants' counsel, Candice S. Cook, Esq., a written communication advising that said trademark registration issued due to a clerical error and was, therefore, canceled.

28. Notwithstanding Ms. Cook's receipt of such notice Applicants, through Ms. Cook acting on their behalf, sent to Opposers' counsel a letter dated April 4, 2014, accusing Opposers of infringing upon Applicants' rights, claiming that "the Dominique Ansel Bakery (the "D.A. Bakery") has registered the trademark Cronut™".

29. Applicants also are using the registration symbol in connection with CRONUT on their website at www.dominiqueansel.com. A true, accurate and correct

copy of a page from that website showing such use of the registration symbol is attached as Exhibit 1.

30. On information and belief, Applicants are intentionally misusing the registration symbol in an attempt to deceive the public into believing their CRONUT mark is registered and also are wrongfully asserting CRONUT is registered in their enforcement efforts.

Count V – Fraud upon the United States Patent and Trademark Office

31. Opposers repeat and reallege paragraphs 1 through 30 as though fully set forth herein.

32. At the time of filing their application to register CRONUT, Applicants, through their attorney Candice S. Cook, Esq., stated in a declaration to the U.S. Patent and Trademark Office as follows:

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

33. On information and belief, at the time Ms. Cook signed said declaration, Applicants had not used the CRONUT mark for the goods in their application.

34. At the time Ms. Cook signed said declaration, her statement that the mark

was in use for all of the goods was a false representation about a material fact.

35. On information and belief, Ms. Cook knew that the representation she made was false, as did Applicants.

36. On information and belief, the statement that the mark was made in connection with all of the goods in the application was intended to deceive the United States Patent and Trademark Office.

37. On information and belief, Applicants knowing of the falsity of their misrepresentation, never took any steps with the United States Patent and Trademark Officer to correct their misrepresentation.

38. On information and belief, the United States Patent and Trademark Office reasonably relied upon the misrepresentation, and as a result published the CRONUT application for opposition purposes.

39. Opposers, having to oppose the CRONUT application, are being damaged as a result of Applicants' misrepresentation.

WHEREFORE, Opposers pray that this opposition be sustained and that application Serial No. 85936327 be refused registration.

Respectfully submitted,

BAKER & HOSTETLER LLP

Dated: New York, N.Y.
October 23, 2014

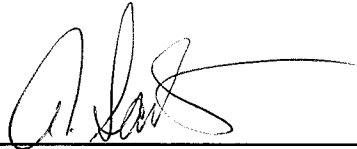
By: 

Robert B.G. Horowitz
Attorneys for Opposer
45 Rockefeller Plaza
New York, N.Y. 10111
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing First Amended Notice of Opposition and Exhibits were served by first class mail, postage prepaid, this 23rd day of October, 2014 in an envelope addressed to Applicant, as follows:

Candice S. Cook, Esq.
Ca-Co Global Inc. / The Cook Law Group
77 Water Street, 8th Floor
New York, New York 10005

A handwritten signature in black ink, appearing to read 'Ana Dos Santos', is written over a horizontal line.

Ana Dos Santos

EXHIBIT 1

DOMINIQUE ANSEL BAKERY

186 Spring St., NY, NY 10012 | (212) 219-2773

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The Cronut™
Half croissant, Half Doughnut
The signature pastry by Chef Dominique Ansel



The Chef

BREAKFAST
LUNCH
SNACK
DESSERT



The Menu

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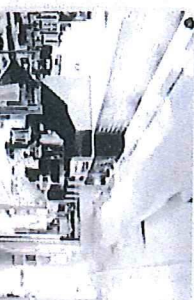


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